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In re Application of
LAHAV et al.
Application No.: 10/018,992
PCT No.: PCT/IL00/00364
Int. Filing Date: 21 June 2000
Priority Date: 22 June 1999
Attorney Docket No.: DO1/2000
For: STABLE BENZIMIDAZOLE
FORMULATION

DECISION ON
PAPERS UNDER 37 CFR 1.42

This is a response to the declaration filed 27 June 2002 which is being treated as a request under 37 CFR 1.42. A two-month extension of time fee under 37 CFR 1.136(a) has been charged to Deposit Account no. 50-2090. No petition fee is required.

BACKGROUND

On 21 June 2000, applicants filed international application PCT/IL00/00364, which claimed a priority date of 22 June 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 28 December 2000. A proper Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire on 26 December 2001.

On 26 December 2001, applicants filed a transmittal letter for entry into the national stage in the United States accompanied, inter alia, by: the basic national fee and a copy of the international application.

On 27 February 2002, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.497 and the surcharge fee required under 37 CFR 1.492(e). The notification set a two-month time period to respond.

On 27 June 2002, applicants filed a declaration and power of attorney executed by Valerie Azoulay as inventor and Erica Lahav on behalf of deceased inventor, Raffael Lahav.

DISCUSSION

A. Request under 37 CFR 1.42

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

The declaration submitted on 27 June 2002 was executed by Erica Lahav as "executrix" of the deceased inventor, Raffael Lahav. The declaration submitted appears to have been executed by the proper party under 37 CFR 1.42, however, the declaration does not satisfy the requirements under 37 CFR 1.497(b)(2).

In addition, it is noted that revised 37 CFR 1.497(b)(2) states the following:

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to revised 37 CFR 1.497(b)(2), in addition to the citizenship and former residence and post office address of the deceased inventor referenced under 37 CFR 1.497(a)(3), the declaration must also provide residence, citizenship, and post office address for the executrix. The declaration filed on 27 June 2002 provides the residence, citizenship, and post office address for only one individual and it is unclear whether this information is for the executrix or the deceased inventor. Accordingly, the declaration is not in compliance with 37 CFR 1.497(b)(2).

CONCLUSION

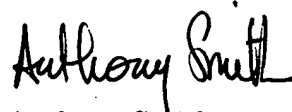
For the above reasons, the request for status under 37 CFR 1.42 is REFUSED.

Applicant is required to provide an oath/declaration in compliance with 37 CFR 1.497(a)-(b) within **TWO (2) MONTH** from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and must include an acceptable declaration under 37 CFR 1.497 which has been executed by the either the legal representative of the deceased inventor or, if no legal representative has been appointed, all of the heirs of the deceased inventor.

Any further correspondence with respect to this matter should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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